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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/228,658
Filing Date: January 12, 1999
Appellant(s): Hans Prinzing et al.

Neil Greenblum
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed February 26, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit: 1731

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-34 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Art Unit: 1731

5,788,817	Bentele et al	6-1999
EP 752,495	Schiel et al	1-1997
DE 19,520,443	Bentele et al	12-1996

Smook, G. A., "Handbook for Pulp & Paper Technologists, 2nd Ed.", (1992),
page 253.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-34 are rejected. This rejection is set forth in prior Office action, Paper
No. 8.

(11) *Response to Argument*

As it relates to the Double-Patenting rejections:

Appellant argues that the pressure of the support elements of the shoe press device disclosed in EP 752,495 should be approximately alike, and that the controls that are provided to reduce the pressure of the shoes function to maintain a uniform pressure between the support elements. Therefore, EP 752, 495 provides no teaching or suggestion of adjusting a differential pressure. However, the examiner finds no language in the EP 752, 495 reference which states that the pressure of the support elements should be approximately alike or that uniform pressure should be maintained between the support elements. In fact, there is at least two statements to the contrary. The disclosure of EP 752,495 states, in column 2, that the shoe press of its invention includes various devices control the pressure to the support elements on

Art Unit: 1731

the shoe press and counter rolls. Also, in column 1, it states that the shoe press shown affords the possibility of *varying the distribution of the pressing force* as desired over the width of the web. This language suggests, if not discloses, means to affect a pressure differential between pressures generated by the support elements in both the shoe press roll and the counter roll.

While Appellants allege that the Examiner's statement of motivation to modify the claims of Bentele et al in view of EP 752,495 was not sufficient in establishing a prima facie case of obviousness, and that motivation must be made without hindsight reconstruction of the invention from the prior art. Also, Appellants state that since the Bentele et al reference failed to teach or suggest the subject matter disclosed in the EP 752,495 reference, there is no motivation or rationale for modifying Bentele et al in accordance with the teaching of EP 752,495. However, the examiner believes that she has provided the requisite motivation. Namely, the ability to change the pressure of the support elements has advantages depending on the type of dewatering is required for the web and allows for varying the distribution of the pressing force as desired over the width. Therefore, one of ordinary skill in the art would have been motivated by this teaching in EP 752,495 to modify the press roll device of Bentele et al in order to appreciate these benefits.

Appellants argue that EP 752,495 discloses a pressure reduction valve to adjust the pressure to compensate for the weight of the roll jacket, not an adjustment device to change a differential pressure, as recited in at least independent claims 1 and 33. However, the Examiner notes that pressure reduction valve 18 functions to change/lower the pressure

Art Unit: 1731

supplied to the pressure elements of the shoe press roll, which satisfies the limitation of the independent claims regarding "an adjustment device arranged to change a differential pressure".

Appellants argue that the Examiner must afford patentable weight to functional limitations that are non-obvious over the prior art and that these functional features cannot simply be ignored. But, the Examiner has stated in prior Office Actions, and still maintains, that claims 4-12 and 18-13 comprise language that imparts limitations that are not structural. Claims directed to an apparatus must be distinguished from the prior art in terms of *structure* rather than *function*. Apparatus claims cover what a device *is*, not what a device *does*. (See MPEP 2114). Therefore, only the recitation in claims 1-32 which impart structural limitations were examined over the prior art.

While Appellant asserts that the Bentele et al and EP 752,495 references, even if properly combined, do not disclose or suggest the various recited parameters of pressure, arrangement of the elements, the interconnection between the elements and other recited features in the dependent claims, the Examiner disagrees and believes these assertions have been sufficiently overcome by the arguments made by the Examiner presented above, in addition to the rejections made over the Prior art as presented in the Final Rejection.

Appellant asserts that the Smook reference fails to teach or suggest any of the subject matter noted as deficient in the Bentele et al claims; therefore, there can be no proper combination of Bentele et al and Smook to arrive at the features of claim 25. However, the

Art Unit: 1731

examiner notes that the purpose of Smook is to further modify the invention of Bentele et al modified by EP 752,495, and the teaching in Smook is proper for establishing that cambering or "crowning" of press rolls is a necessary and conventional practice in the papermaking art that is performed in order to achieve a uniform pressure profile across the contacting face of the press roll. For this reason, one of ordinary skill in the art would have been motivated to further modify the invention of Bentele et al modified by EP 752,495.

As it relates to the Prior Art rejections:

Appellant asserts that the Bentele et al reference discloses throttles provided to ensure a greater pressing pressure being applied at the press roll than at the backing roll. However, Bentele et al fails to disclose the specifics of the throttles or disclose or suggest an information with regard to adjustability. However, the Examiner has acknowledged, particularly in the Final Rejection, that while Bentele et al appears to be silent with respect to adjustability of a pressure differential, the EP 752,495 reference provides the requisite motivation to modify Bentele et al by adding means to adjust the pressure differential.

All of Appellants arguments with respect to the Prior Art (35 USC 103) rejections based on Bentele et al and EP 752,495 are the same as those presented regarding the Double Patenting rejections over the same art; therefore, the Examiner refers the readers attention to the above-stated, respective arguments.

Additionally, the arguments with respect to the Double Patenting rejections based on the Bentele et al reference also apply to the prior art rejections regarding the DE 19,520,443

Art Unit: 1731

reference, since that are equivalents of each other; therefore, the Examiner refers the reader's attention to the above-stated, respective arguments.

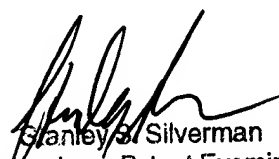
Art Unit: 1731

For the above reasons, it is believed that the rejections should be sustained.

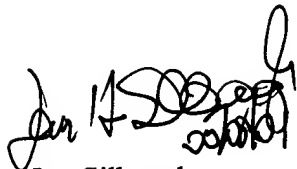
Respectfully submitted,



DAW
May 4, 2001



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Application/Control Number: 09/228,658

Page 9

Art Unit: 1731

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